

REMARKS

The present application is a U.S. national application of PCT Application No. PCT/IL00/00319 filed on June 4, 2000. The application contains claims 1-70. Claims 1 and 70 are independent claims. Claim 66 has been amended. The response refers primarily to the independent claims. The patentability of the dependent claims follows at least for the reason of being dependent on an independent claim that is patentable.

On page 2 the Examiner states that claim 66 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Applicants have amended claim 66 to amend an obvious typographical error.

On page 2 the Examiner states that claims 1-9, 11-18, 20-58, 60-63, 65, 66 and 68-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/15317. Applicants respectfully disagree. The Examiner has not shown a *prima facie* case of obviousness (MPEP 2143.01) since the Examiner has not shown motivation in the prior art for creating "at least one electric field including a transport effect for transporting a molecule in a desired manner and a non-excitatory control effect for controlling the activity of at least a part of a heart" as required in the claims. WO 98/15317 does not suggest an electric field for creating a non-excitatory control effect, in WO 98/15317 the switches appear to relate to a discharge function used when no drug is released (e.g. page 13 lines 5-14).

Additionally, the Examiner has not shown a *prima facie* case of obviousness (MPEP 2143.02) since the Examiner has not shown reasonable expectation of success in creating "at least one electric field including a transport effect for transporting a molecule in a desired manner and a non-excitatory control effect for controlling the activity of at least a part of a heart" as required in the claims. In WO 98/15317 the transport effect is only achieved during pacing which is an excitatory controlling effect, there is no teaching how to create a non-excitatory effect (e.g. page 13 lines 5-14), nor how changing the switches would produce such an effect.

On page 3 the Examiner states that claims 10, 19, 59, 64 and 67 contain allowable subject matter. Applicants thank the Examiner for the indication.

Applicants bring to the Examiner's attention that the following book: WEBSTER, J. G.; "Design of Cardiac Pacemakers;" 1995; Institute of Electrical and Electronics Engineers, Inc.; New York, NY, cited in the specification of the present application (on page 14, line 34), is believed to be of background relevance only for the present application. Applicants are therefore

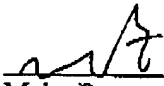
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not providing a copy of this book.

In view of the above comments and amendments, an allowance of all the claims is respectfully awaited.

If the Examiner is unable to agree that the claims are all patentable, he is respectfully requested to contact the undersigned at toll free +1 (877) 428-5468. This number connects directly to our office in Israel. Please note that Israel is 7 hours ahead of Washington and that our work week is Sunday-Thursday.

Respectfully submitted,
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Maier Fenster
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September 22, 2004

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